



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/878,245

06/12/2001

Katrina L. Dewar

2951.03US02

3786

7590 01/22/2008
Brad Pederson, Esq.
Patterson, Thunte, Skar & Christensen
4800 IDS Center, 80 S. 8th Street
Minneapolis, MN 55402-2100

EXAMINER

WONG, LUT

ART UNIT

PAPER NUMBER

2129

MAIL DATE

DELIVERY MODE

01/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/878,245

Applicant(s)

DEWAR, KATRINA L.

Examiner

Lut Wong

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to an AMENDMENT entered Nov 19, 2007 for the patent application 09/878245.

Status of Claims

Claims 15-17 are independent and pending. Claim 17 has been amended.

Response to Arguments

Applicant's responses to the "request for information have been fully considered.

Applicant's amendment to claim 17 has overcome the 112 1st rejection.

Claim Rejections - 35 USC § 102

Claims 15-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Paul W. Brooks, as set forth in the previous office action for reason of record.

Response to Arguments

Applicant's arguments filed Nov 19, 2007 have been fully considered but they are not persuasive.

In re pg. 7, applicant argues that Dewar affidavit properly established a basis for swearing behind the Brooks presentation.

In response, the declaration under 37 CFR 1.132 filed Nov 19, 2007 is insufficient to swear behind the date because there is no evidence provided.

In re pg. 7, applicant argues that Brooks presentation was derived from the inventor.

In response, the declaration by Dewar under 37 CFR 1.132 filed Nov 19, 2007 is insufficient.

MPEP 2132.01 states

"if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, applicant's affidavit will not be enough to establish that applicant is the sole inventor and the rejection will stand."

In instant case, there is 1) no mentioning of Inventor's name in Brooks' reference. 2) no evidence provided by the Inventor to support his disclaiming affidavit. It is still reasonable to believe that Brooks' reference does not derive from the Inventor unless applicant can prove otherwise.

Claim Rejections - 35 USC § 103

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul W. Brooks ("Internet Assessment: Opportunities and Challenges" IPMAAC June 4th 2000), further in view of Ogden (US 6311164) as set forth in the previous office action for reason of record.

Response to Arguments

Applicant's arguments filed Nov 19, 2007 have been fully considered but they are not persuasive. See the response above that the affidavit is insufficient.

Claim Rejections - 35 USC § 102

Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Decision Point Data, Inc ("1999 StoreWorks! Conference and Exhibition," 13 pages, May 1999. Referred herein as DPD) as set forth in the previous office action for reason of record.

Response to Arguments

Applicant's arguments filed Nov 19, 2007 have been fully considered but they are not persuasive.

In re pg. 8, applicant argues "The StoreWorks document lacks a publication date."

In response, the StoreWorks conference & Exhibition was held in May 16-19, 1999. See appendix A.

In re pg. 9, applicant argues that the standardized questions across a company does not teach or suggest a set of validated question that are statistically validated to correlate job performance rating with previous responses.

In response,

1) As set forth in the rejection, the argued limitations are drawn to performance related question.

2) EN ¶1 applies. There is no mentioning of "statistically validated" in the claim.

3) Applicant should also note that whether the questions are standard questions or not, it makes no difference. The questions presented to the applicant are inherently "validated by correlating job performance ratings of a plurality of hired workers with previous responses give by the workers to the application questions before the works were hired". The presented questions must be effective in hiring quality candidates. It would not make sense to present a question that is ineffective. This means the question must be made from past experience (such as response from previous hires). The fact that follow up questions were provided in the order of importance shows that high ranked questions are more likely to result in hiring quality employee from the past experience. See e.g. Fig. 5 on sample follow on questions.

In re pg. 10, applicant argues that MPEP 2111.04 [R-3] is not applicable to the limitation of "the short subset being selected to serve as a fast job-related pre-screen"

In response, the Examiner does not see any step being performed rather than an intended result. If the applicant can shows there is an actual step being performed, the Examiner would agree.

In re pg. 10, applicant argues that StoreWorks document lacks a "set of validated questions being a short subset of a large assessment"

In response, the Examiner disagrees. It is readily clear that the question asked is just a small subset of a large assessment. The fact that follow up questions were provided means the initial set of question are just a small subset. See e.g. Fig. 5 on

sample follow on questions. Also, even the follow on question are a subset because not all of the validated question are being used.

In re pg. 10, applicant argues that without the claim element of taking a set of validated question that can be used as a fast job-related pre-screen the StoreWorks document cannot anticipate the claimed limitation

In response, the Examiner disagrees. As explained above, such limitation is intended result. Nevertheless, StoreWorks still anticipates the claim. The question presented are indeed a short subset used for pre-screening. The fact that follow up questions were provided means the initial set of question are just a small subset for pre-screening. See e.g. Fig. 5 on sample follow on questions.

Claim Rejections - 35 USC § 103

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Decision Point Data, Inc ("1999 StoreWorks! Conference and Exhibition," 13 pages, May 1999. Referred herein as DPD), further in view of Ogden (US 6311164) as set forth in the previous office action for reason of record .

Response to Arguments

Applicant's arguments filed Nov 19, 2007 have been fully considered but they are not persuasive.

In re pg. 10, applicant traverse claim 17 for the same reason set forth above.

In response, see the response above.

Examiner Note (EN)

¶ 1: The claims and only the claims form the metes and bounds of the invention.

Limitations appearing in the specification but not recited in the claim are not read into the claim. The Examiner has full latitude to interpret each claim in the broadest reasonable sense. There is no mention of these limitations in the claims and the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art; see In re Sprock, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Application/Control Number:
09/878,245
Art Unit: 2129


Page 8

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lut Wong whose telephone number is (571) 270-1123. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent David can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lut Wong/
Patent Examiner, AU 2129


DAVID VINCENT
SUPERVISORY PATENT EXAMINER